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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,017	11/22/2000	Winnie C. Durbin	GEMS8081.023	5745
27061 7590 08/20/2009 ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS) 136 S WISCONSIN ST PORT WASHINGTON, WI 53074				
EXAMINER JOHNS, CHRISTOPHER C				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 08/20/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/681,017

Applicant(s)

DURBIN ET AL.

Examiner

Christopher C. Johns

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No./Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20090808 for reference purposes only.
2. This Office Action is in response to the Request for Continued Examination (filed 12 May 2008), the Declaration under 37 CFR §1.131 (filed concurrently), and the Petition under 37 CFR §1.183 to suspend the rules under 37 CFR §1.131 (filed 6 January 2009).
3. All references to the capitalized version of “Applicant” refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of “applicant” or “applicants” refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. The Examiner in this case has changed to Christopher Johns. Please address all future correspondence to Examiner Johns, whose contact information is contained at the end of this Action.
5. The new art which has been applied in this Action (Manduley, United States Patent 5,956,505) was originally cited to the Applicants in the related PCT case PCT/US01/44134. It appears that this art (nor the rest of the art in the PCT case) was not cited by Applicants, so the Examiner has cited it on his PTO-892 form.
6. Claims 1-26 are pending.

Continued Examination Under 37 CFR 1.114

7. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 May 2008 has been entered.

Antedating Affidavit under 37 CFR §1.131

8. The antedating affidavit filed on 12 May 2008 under 37 CFR 1.131 is sufficient to overcome the Leovac (United States Patent 6,668,375) reference.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-7, 10-15, 17, 18, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 6,272,636 ("Neville") in view of Manduley.

11. As per claims 1-3, 23, and 24, Neville teaches:

12. receiving a user ID at a centralized facility from a user (column 13, lines 17-20 - "client application executing on the end-user 806 computing device provides a request/used ID 808 to the server/clearinghouse");

13. receiving a...request from the user specifying an option requested to be enabled in equipment at a subscribing station (column 13, lines 17-20 - “client application executing on the end-user 806 computing device provides a request/used ID 808 to the server/clearinghouse”);
14. at the centralized facility, confirming that the option has not already been enabled (column 13, lines 30-35 - “if the user is not to be allowed use of this application...server does not transmit the unlock key 803 to the end-user 806 computing device...”);
15. sending an enabling feature from the centralized facility to the equipment in the subscribing station (column 13, lines 25-27 - “server transmits the unlock key 803 to the end-user 806 computing device executing the client application”);
16. activating the option in the equipment (column 13, lines 27-31 - “client application makes use of unlock key 803 to decrypt previously encrypted portions, i.e., as encrypted by the builder program”).
17. According to the Board of Patent Appeals and Interferences Decision (Appeal Number 2006-0490, hereafter “Decision”), decided 9 May 2006, Neville does not explicitly disclose:
18. receiving an option-enabling request.
19. Neville does disclose that the software which is usable before activation (“the client application”; column 13, lines 15-16) is a portion of a software product which is not usable before activation (“metered digital product **200**”; column 13, lines 15-16); therefore, the remainder of the software product (that is, the “metered digital product” **200**’ minus the “client application”) can be seen as the “option” (as it is the “item” which is “offered in addition to...standard equipment” (Decision, page 13, final paragraph), the “standard equipment” being

the remainder of the software product) which must be enabled by the transmission that takes place in column 13. Therefore, it appears that Neville does teach an “option-enabling” request.

20. Nonetheless, Manduley teaches:

21. receiving an option-enabling request (Abstract - “a method is provided for activating an optional feature...method also includes receiving a request to operate one of the optional features”).

22. The sole difference between the reference and the instant application is that the reference does not disclose an “optional feature” in place of the program itself (as Neville purportedly discloses). Since each individual feature-activating system and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of the optional feature activation system in Manduley for the program activation system in Neville. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use Manduley’s feature activation system in place of Neville’s activation system, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary skill in the art would also find it advantageous because it would enable a “more convenient and less expensive method of distributing rate or other types of optional data packages” (column 2, lines 17-23).

23. As per claim 4, 5, 15, and 25, Neville in view of Manduley discloses as above, and further discloses:

24. equipment includes medical imaging scanners (column 10, lines 62-67 - "end user's computer" - encompasses all computer types, including a medical scanner)

25. designing a software key to enable the option for a predetermined trial period (figure 3-b, reference 110).

26. As per claims 6 and 7, Neville in view of Manduley discloses as above, and further discloses:

27. authenticating the user ID after receiving the user ID at a centralized facility (column 13, lines 23-27 - "whether the user is authorized");

28. downloading the enabling feature to the equipment and remotely enabling the feature automatically and without further user input (column 13, lines 25-27 - "transmits the unlock key 803 to the end-user 806 computing device executing the client application. The client application makes use of unlock key 803...").

29. As per claims 10-14, 17, and 18, Neville in view of Manduley discloses as above, and further discloses:

30. creating an option key (column 13, lines 22-27);

31. transmitting an option key through a communications network (column 13, lines 22-27);

32. system ID (the server/clearinghouse in Neville needs to know at least where to send the data to, using an ID such as an IP address);

33. send an electronic verification of the option enablement (the data sent to enable the option is sent from the first computer over a network to a second computer; see column 13, lines 23-30).

34. Claims 8, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville in view of Manduley, further in view of United States Patent 6,360,254 ("Linden").

35. As per claims 8, 9, and 16, Neville in view of Manduley discloses as above, but does not explicitly disclose:

36. verifying the option activation;

37. FTP or email the option key to a user;

38. sending a verification email to the user confirming option enablement.

39. Linden teaches:

40. verifying the option activation, email the option key to a user, sending a verification email to the user confirming option enablement (column 11, lines 28-39 - "the private URL/hyperlink 74 is transmitted to the user via an order confirmation email 72, and provides access to a private Web page 78 that includes order status information or other account-related information").

41. This is done in order to create an efficient way of distributing data (column 5, lines 42-57).

42. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Neville and Manduley the email confirmation as taught by Linden, since the claimed invention is merely a combination of old elements, and in the combination, each element merely

would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a efficient way of distributing data.

43. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neville in view of Manduley, further in view of United States Patent 4,888,798 ("Ernest").

44. As per claim 19, Neville in view of Manduley teaches as above, but does not explicitly disclose:

45. creating a disabling feature.

46. Ernest teaches:

47. creating a disabling feature (column 14, line 66 - column 15, line 30; "when U_c has been decremented to zero...").

48. Claims 20-22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville in view of Manduley, further in view of United States Patent 6,115,471 ("Oki").

49. As per claims 20-22 and 26, Neville in view of Manduley discloses as above, but does not explicitly disclose:

50. receive and authenticate a user ID prior to receiving a request.

51. Oki discloses:

52. receive and authenticate a user ID prior to receiving a request (column 7, line 55 - column 8, line 11; "Then, the host computer checks the user identifier ID and the user password (step S42). If these data is not correct (NG), the process is finished. If the user ID and the user

password are correct (OK), the host computer automatically reads and checks the terminal ID and the terminal password stored in the terminal (step S43). If the terminal ID and the terminal password are not correct, it can be considered that data have been illegally copied, and a process against the illegal action is performed (step S44). If the terminal ID and the terminal password are correct (OK), the host computer displays the list of software programs to be sold on the screen of the terminal, and the user can choose a software program from the list (step S45)").

53. This is done in order to verify that data has not been illegally copied and that the user and terminal are authorized to receive data.

54. The sole difference between the reference and the instant application is that the reference does not disclose verifying a user ID before receiving a request in place of verifying after receiving a request. Since each individual user verification system and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of verifying before a request in Neville. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the pre-request verification system in place of a post-request verification system, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious. A person having ordinary skill in the art would also find it advantageous because it would prevent those who are not authorized from wasting bandwidth and resources by communicating when they should not be able to.

Response to Arguments

55. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new grounds of rejection.

Conclusion

56. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. United States Patent 5499295 (Cooper);
- b. United States Patent 5715823 (Wood);
- c. PCT Publication WO/98/53384 (Carlsund).

57. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

58. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

59. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621